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09/017,959	02/03/1998	DAVID A. BERNHARDT	8117-000021	9076

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EXAMINER

PIERCE, WILLIAM M

ART UNIT

PAPER NUMBER

3711

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26

Please find below and/or attached an Office communication concerning this application or proceeding.



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BEFORE THE BOARD OF PATENT APPEALS
AND INTERFERENCES

Paper No. 26

Application Number: 09/017,959

Filing Date: February 03, 1998

Appellant(s): BERNHARDT, DAVID A.

Duke Taylor
For Appellant

MAILED
MAR 21 2002
GROUP 3700

EXAMINER'S ANSWER

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This is in response to the appeal brief filed 1/15/02.

(1) Real Party in Interest

A statement identifying the real party in interest is contained in the brief.

(2) Related Appeals and Interferences

A statement identifying the related appeals and interferences which will directly affect or be directly affected by or have a bearing on the decision in the pending appeal is contained in the brief.

(3) Status of Claims

The statement of the status of the claims contained in the brief is correct.

(4) Status of Amendments After Final

The appellant's statement of the status of amendments after final rejection contained in the brief is correct.

(5) Summary of Invention

The summary of invention contained in the brief is correct.

(6) Issues

The appellant's statement of the issues in the brief is correct.

(7) Grouping of Claims

The appellant's statement in the brief that certain claims do not stand or fall together is not agreed with because claims 17-20 and 21-28 are not separately argued. As such claims 17-28 stand or fall together

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(8) **ClaimsAppealed**

The copy of the appealed claims contained in the Appendix to the brief is correct.

(9) **Prior Art of Record**

The following is a listing of the prior art of record relied upon in the rejection of claims under appeal.

D97360

Stevens

10-1935

(10) **Grounds of Rejection**

The following ground(s) of rejection are applicable to the appealed claims:

Note: the rejection of claims 17-28 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention as set forth in prior Office action, Paper No. 20 has not been sustained for the reasons set forth below in Response to Argument.

Claims 17-28 are rejected under 35 U.S.C. 102(b). This rejection is set forth in prior Office action, Paper No. 20.

(11) **Response to Argument**

Appellant's first three paragraphs on pg. 3, providing a summary of his invention, are noted with no response deemed necessary.

In the second to last paragraph of pg. 3, Appellant takes exception to the fact that the applied reference is a design patent and that it has no specification. While he fails to state any authority as to why this issue is important, it appears that appellant finds this important since it does not mention using shown apparatus in Stevens

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with a bowling ball. This argument was settled on the bottom of pg. 7 of the Board Decision 1/30/01, paper No. 17 and no further comment is deemed necessary.

Secondly, at the bottom of pg. 3, appellant cites case law of *In re Spada* whose application to the issues at hand were decided previously at the top of page 6 of the Board Decision 1/30/01, paper No. 17. No further comment is deemed necessary. Appellant subsequently offers the argument that each and every limitation is not set forth by Steven. However, such is not true since the functional limitations in the claims are treated as being inherent based only on the intended use of the finger cot. Further, appellant has not offered any evidence to rebut examiners position of inherency. This argument is settled on pg. 6 and the top of pg. 7 of the Board Decision 1/30/01, paper No. 17. Appellant argues in the middle of pg. 4 that the intended use limitations of "projections flatten" and "the tips of the projections define a curve which has a curvature substantially like a curvature of a bowling ball when force is exerted by the bowler on the ball" are not shown in Stevens. Such is not true since the apparatus of Steven is inherently capable of performing the functional limitations. Fig. 2 of Stevens clearly shows projections with "a curvature substantially like a curvature of the bowling ball" (cl. 17, ln. 6). When used for bowling these projections would be expected to "flatten out" inherently meeting each and every limitation of the claim. Note that skill is presumed on the part of those practicing in the art. See *In re Sovish*, 769 F.2d 738, 743, 226 USPQ 771, 774 (Fed. Cir. 1985) and that in evaluating a reference, it is proper to take into account not only the specific teaching of the reference(s) but also the inferences which one skilled in the art would reasonably be expected to draw therefrom. In *re Preda*, 401 F.2d 825, 826, 159 USPQ 342, 344 (CCPA 1968). Additionally, one must observe that an artisan must be presumed to know something about the art apart from what the references disclose (see *In re Jacoby*, 309 F.2d, 513, 516, 135 USPQ 317, 319 (CCPA 1962)).

In the second to last paragraph of pg. 4, appellant reaches for the argument that Stevens would not have been "placed (it) in possession of a person of ordinary skill in the field of the invention". Assuming a bowler would only consider brushing his teeth with the Steven's apparatus. However, the apparatus shown by Stevens belongs to a class of devices known as "finger cots" generally used for protecting the finger or improving grip. The problem at hand is improving grip and protecting the fingers and not bowling per se. Clearly a bowler concerned with the problem of protecting the finger or improving a grip would have been in possession what is known in the prior art of "finger cots".

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While appellant does not directly make an argument of non-analogous art, such is implied. However, it is clearly stated in MPEP 2131.05 that "arguments that the alleged anticipatory prior art is 'nonanalogous art'...is not 'germane' to a rejection under section 102". See Twin Disc, Inc. V United States, 231, USPQ 417, 424 (Cl. Ct. 1986)(Quoting In re Self, 617F.2d1344, 213 USPQ 1, 7 (CCPA 1982). Further this argument is settled at the bottom of pg. 5 of the Board Decision 1/30/01, paper No. 17.

With respect to the issues under 112 the examiner set forth in the final office action of 6/04/01, while the appellant has been reluctant to make amendments to the claims or remarks to clarify the scope of the claim, the examiner has not sustained this rejection for the appeal. However, he makes of record here that the scope of the claims are being considered to pertain only to the subcombination of an "accessory" which does not require the combination of a bowling ball.

For the above reasons, it is believed that the rejections should be sustained.

Respectfully submitted,



WILLIAM M. PIERCE
PRIMARY EXAMINER

wp
3/20/02

CONF:



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